REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-24 are pending in the present application. Claims 1, 7, and 13-19 have been amended. Claims 1, 7, 13, and 19 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

Claim for Priority

It is gratefully acknowledged that the Examiner has recognized Applicants' claim for foreign priority. However, in the Office Action, the Examiner indicated that only some of the certified copies of the priority documents have been received. Applicants find this indication curious since the present application only claims priority under 35 U.S.C. § 119 to only *one* foreign application, JP 2002-283889, the certified copy of which was filed on September 25, 2003. Thus, Applicants respectfully submit that the claim for foreign priority has been perfected, and no additional action is required from Applicants at this time.

Rejection Under 35 U.S.C. § 101

Claims 13-24 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As to claims 13-18, the Examiner asserts that these claims are non-statutory as being directed to a computer program *per se*. However, in the above amendments, Applicants have rewritten these claims as system claims. Applicants respectfully submit that the claimed system is a statutory class of invention under § 101.

As to claims 19-24, the Examiner asserts that the claimed "computer readable recording medium" could cover a non-tangible thing, in view of the specification. Particularly, the Examiner refers to the specification at page 14, line 26 – page 15, line 10 as defining the

computer readable recording medium as encompassing an internet download, i.e., a signal. First, Applicants have amended claim 19 to refer to a "computer readable storage device—recording medium." Further, Applicants have amended the cited portion of the specification to indicate that such storage devices may include "devices for storing internet downloads." In view of these amendments, Applicants respectfully submit that claims 19-24 are directed to tangible things and, as such, are statutory.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1-3, 5-9, 11-15, 17-21, 23, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by anticipated by US Patent No. 5,982,381 to Joshi et al. (hereafter "Joshi"). Claims 4, 10, 16, and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Joshi in view of EP Publication No. 0924648A2 to Ohta et al. (hereafter "Ohta").

Alternatively, claims 1, 3-7, 9-13, 15-19, and 21-24 stand rejected under § 102(b) as being anticipated by Ohta. Claims 2, 8, 14, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohta in view of Joshi.

In both sets of rejections, the Examiner relies on Ohta to teach that the natural-image and CG image regions of a synthesized image are separated by removing a region based on the color of that region (see Office Action at page 10, 1st paragraph, and page 12, 3rd paragraph). Particularly, the examiner cites Page 3, lines 15-24, in Ohta for this feature. This section of Ohta is reproduced below:

15 [0018] The first invention further provides a storage medium storing thereon a program for controlling a computer, the program causing the computer to accept an area to be extracted which is designated on an original image displayed on a display screen. to replace image data representing an image of an area excluding the accepted area to be extracted with image data representing a specified color on the image data of the original image to generate pairs of pixel data and coordinate data from the image data excluding the image data representing the specified color, and to store the
20 generated pairs of the pixel data and the coordinate data on a storage medium.
[0019] According to the first invention, since the image data in the area (background area) other than the area which has been specified to be extracted (cut out) are replaced with image data representing the particular color, the image data of the specified (designated) area can be easily obtained merely by extracting other image data than the image data which represent the particular color

However, Applicants respectfully point out to the Examiner that the above-cited paragraphs in Ohta do *not* refer to a *synthesized image*. Instead, this passage refers to Ohta's *first embodiment*, in which an *original image* is separated into an accepted area (specified by user by moving the cursor) and a background area. This is described in page 6, lines 31 et seq., of Ohta, which is reproduced below:

[0054] The image processing (recording/reproducing) apparatus displays a desired image (an original image) on the display device 10. extracts a part of the image (a partial image) from the original image displayed on a screen of the display device 10. edits the extracted partial image. and records on the FD 17 image data representing the edited image. The image data representing the partial image extracted from the original image may be recorded on the FD
35 17. as required
[0055] With reference to examples of display images of the display device 10 shown in Fig. 3 to 10. processing in the image processing apparatus is explained in accordance with a flowchart shown in Fig. 16
[0056] Image data representing one or a plurality of original images are stored in the FD 17, the CD-ROM 18 or the hard disk in advance. Image data which represent a desired original image is read out from one of above storage media
40 by the FD drive 7. the CD-ROM drive 8 or the HD drive 9 (step 21). The image data read out is temporarily stored in the display memory 4. The original image represented by the image data stored in the display memory 4 is displayed on a display screen of the display device 10 as shown in Fig. 3
[0057] It should be understood that Fig. 3 shows the original image displayed on a part of the display screen of the display device 10. Generally an window appears on the display screen and the original image is displayed within the
45 window. In this case. the rectangular frame within which the original image appears shown in Fig. 3 represents a contour of the window
[0058] The original image may be an image appearing on a film. a photograph and other visible media. In this case. the original image on the visible medium is read by the scanner 11. and the original image is displayed using the image data obtained by the scanner 11.
50 [0059] An image area A1 to be extracted (cut out) is designated using the mouse 13 by a user in a state where the original image is displayed on the display screen of the display device 10 (step 22). That is, the contour of the image area A1 to be extracted (cut out) is drawn by moving a cursor displayed on the screen using the mouse 13. The drawn contour is memorized in the display memory 4 in the form of contour image data (the image data representing the contour is overwritten)
55 [0060] In the display memory 4. the image data of pixels which reside outside the contour (within the window of course) on the image are replaced with image data representing a specified color (the image data representing the specified color are overwritten). Preferably. the specified color is a color which does not exist in a nature image (a picture of a scene) or a color probability of which is very low (for example. a color the primary color (R. G. B) data of

The original image in Ohta's first embodiment is not a synthesized image, as claimed. In paragraph 0058, Ohta teaches that the original image is scanned in from a film, photograph, or other visible medium, rather than being synthesized from a natural image and computer graphic

(CG) image. Thus, the original image is more analogous to the claimed natural image, rather than the synthesized image. Further evidence of this is found in paragraph 0060 of Ohta, which teaches that the pixels of the original image that are outside the accepted region (contour) should be replaced with "a color which does not exist in a *natural image*" (emphasis added), thereby making it easier to discriminate the accepted region.

In fact, in the Office Action, the Examiner does not even rely on the original image in Ohta's first embodiment to teach the claimed synthesized image. Instead, the Examiner relies on the *composite image* disclosed in Ohta's *second embodiment* for the claimed synthesized image. In particular, the Examiner cites Figs. 26 and 27 in Ohta as teaching performing image processing on an image synthesized from a natural image and a computer graphic (CG) image (see Office Action at page 11). Figs. 26 and 27 are part of Ohta's *second embodiment* in which a *composite image* is separated into a user image and template. Also, the Examiner particularly relies on step 132 in Fig. 27 to teach separating the synthesized image into the natural-image region and CG-image region. In this step, Ohta expressly teaches that "the template image and the user image are separated from the *composite image*" (see paragraph 125).

Applicants further point out that, according to Ohta's second embodiment, the separation of the composite image into the template image and user image is performed by reading data in the *mask information*, rather than by removing pixels of a specified color from the composite image. See paragraphs 0115, 0118, and 0125.

In view of the foregoing, Applicants respectfully submit that the Examiner has failed to provide a teaching or suggestion of separating the claimed synthesized image into a natural-image region and a CG-image region by removing pixels of a specific color from the synthesized image. As such, it is respectfully submitted that the various outstanding rejections under §§ 102 and 103 have been obviated because the Examiner has failed to point out a teaching or suggestion of every claimed feature in the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw these rejections.
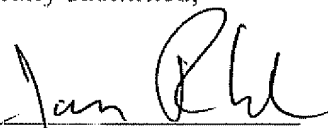
Conclusion

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: June 28, 2007   Respectfully submitted,

By _____ #47,305
Michael R. Cammarata
Registration No.: 39,491
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant